

## STATUS OF CLAIMS

Claims 48-69 are pending in this application, claims 1-47 have been cancelled previously. Claims 48 and 66 are the independent claims.

The specification is amended to update the status of parent application 10/301,984, obviating the Examiner's objection.

## REMARKS

### **Rejection Under 35 U.S.C. §112, second paragraph**

Claims 48-65 stand rejected under 35 U.S.C. §112, second paragraph because of the phrase *traversed by the workpiece*. In particular, the Examiner notes that claim 48 allegedly encompasses an arrangement in which the workpiece is aligned and moved in front of the aperture of a conical mirror. Claim 48 has been amended to recite that the conical mirror has an apex with an aperture *through which the workpiece passes*. Accordingly, an arrangement in which the workpiece is simply aligned and moved in front of the aperture of a conical mirror no longer reads on this limitation. Rather, as shown in FIG. 2 of Applicant's specification, the workpiece must pass through the aperture of the conical mirror.

Accordingly, for this reason, Applicant respectfully requests that the rejection of claims 48-65 under 35 U.S.C. §112, second paragraph be withdrawn.

### **Rejection Under 35 U.S.C. §103(a)**

Claims 48-69 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shapovalov et al. (U.S. Patent No. 6,563,080) in view of Freedenburg et al. (U.S. Patent No. 5,620,618), Weerasinghe et al., GB 2244851 and Presseler (U.S. Patent No. 6,705,736). These rejections are hereby traversed for the following reasons.

In accordance with the present invention, a method is provided for manufacturing a medical device from a workpiece. The method begins by generating a beam of radiation from a radiation source. The radiation beam is directed onto the workpiece by scanning the radiation beam so that a prescribed pattern is cut in the workpiece. A conical mirror is positioned along an optical path between the radiation source and the workpiece. The conical mirror has an apex with an aperture through which the workpiece passes.

As the Examiner recognizes, neither Shapovalov et al., Freedenburg et al. nor Weerasinghe et al. show a conical mirror having an apex with an aperture therethrough that is traversed by the workpiece. The Examiner asserts that this claimed feature is shown in Pressler.

Pressler shows a mirror formed from two conical sections. As shown in FIG. 2 of the reference, the larger of the conical sections has an apex with aperture. The mirror is used to collect light in a telescope.

As previously mentioned, claim 48 has been amended to recite that the conical mirror has an apex with an aperture through which the workpiece passes. By way of example, FIG. 2 of Applicant's specification shows a workpiece 116 that passes through the aperture of the conical mirror 112.

The Examiner alleges that Pressler may be combined with the arrangement formed from the combination of Shapovalov et al., Freedenburg et al. and Weerasinghe et al. so that the aperture would serve as a line of focus in the optical path to align the workpiece. Assuming *arguendo* that this proposed combination is proper, it nevertheless fails to show each and every limitation of the claimed invention. In particular, the proposed combination fails to show the workpiece passing through the aperture of the conical mirror.

It is axiomatic that all elements of the claim must be found in the prior art. The Examiner has not pointed to anything in Pressler or any of the remaining cited references that show or suggest, alone or in combination, an arrangement in which the workpiece passes through the aperture of the conical mirror. Accordingly, since neither Pressler or any of the other references cited by the Examiner show or suggest a *conical mirror having an apex with an aperture through which the workpiece passes*, as set forth in claim 48 of the present application, claim 48 and the claims that depend therefrom are believed to be patentable over the cited references.

In regard to independent claim 66, the claim has been amended to recite that the beam of radiation is generated by a *stationary* radiation source. Accordingly, claim 66 now sets forth that the radiation beam is scanned about the circumference of the tubular workpiece while the radiation source remains stationary and without rotation of the tubular workpiece. As the Examiner notes, the arrangement formed from the combination

of Shapovalov et al., Freedenburg et al. and Weerasinghe et al. requires rotation of the laser beam. Accordingly, the combination proposed by the Examiner fails to show or suggest scanning the radiation beam about the circumference of the tubular workpiece while the radiation source remains stationary, as required by independent claim 66. Accordingly, for at least this reason, claim 66 of the present application and the claims that depend therefrom are believed to be patentable over the cited references.

Accordingly, Applicant respectfully requests that the rejection of claims 48-69 under 35 U.S.C. §103(a) be withdrawn.

### **Conclusion**

In view of the foregoing, it is believed that the application is now in condition for allowance, and early passage of this case to issue is respectfully requested. If the Examiner believes there are still unresolved issues, a telephone call to the undersigned would be welcomed.

### **Fees**

The one-month extension fee (\$130) and any additional fees that may be due as a result of this Amendment may be charged to the undersigned attorney's PTO Deposit Account number 50-1047.

Respectfully submitted,

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